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Gerhard Schwenk

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EXAMINER

LEWIS, JUSTIN V

ART UNIT

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3725

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/575,079	Applicant(s) SCHWENK ET AL.	
	Examiner JUSTIN V. LEWIS	Art Unit 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9-30 and 32-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,9-30 and 32-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicants' amendment, filed on 30 November 2009, is acknowledged.

Amended claims 1, 15, 21-25, and 34 have been entered. Accordingly claims 1, 3-7, 9-30 and 32-34 are currently pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 6-7, 10-11, 15-16, 21-23 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,259,907 to Soules et al. ("Soules") in view of U.S. Patent No. 4, 455,039 to Weitzen et al. ("Weitzen").

Regarding claim 1, Soules discloses a value document, comprising a value document substrate (see col. 11, lines 16-21) and a feature substance (intermediate

Art Unit: 3725

layer 72) for enabling checking of the authenticity of the value document, said feature substance being incorporated into and distributed within the volume and substance of the substrate of the value document (see fig. 7), wherein said substance is distributed substantially uniformly within the volume and substance of the value document substrate (see fig. 7), and comprises a mixture of luminescent substances having a complex spectral distribution (see col. 11, lines 11-15), said complex spectral distribution providing by its spectral characteristics a coding (see col. 11, lines 16-21), but fails to disclose a second feature substance that is formed by a luminescent substance which is provided on the value document substrate in the form of a coding, said coding also enabling value recognition of the document.

Weitzen teaches the concept of providing a second feature substance (coating in the form of bands 3, 4 and 5) that is formed by a luminescent substance which is provided on the value document substrate (see col. 1, lines 31-35) in the form of a coding (see col. 1, lines 37-38), said coding also enabling value recognition of the document (see col. 3, lines 58-61).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to place the Weitzen coating upon the Soules value document as desired during its production, in order to render the document more difficult to counterfeit, as explicitly taught by Weitzen (see col. 1, lines 31-33).

Regarding claim 6, Soules in view of Weitzen discloses the value document according to claim 1, wherein the coding of the second feature substance extends over a predominant part of a surface of the value document (see Weitzen fig. 1).

Regarding claim 7, Soules in view of Weitzen discloses the value document according to claim 1, wherein the coding provided by the second feature substance is a bar code (see Weitzen col. 1, lines 37-38).

Regarding claim 10, Soules in view of Weitzen discloses the value document according to claim 1, wherein the value document substrate comprises a printed or unprinted plastic film (see Soules col. 15, lines 17-19).

Regarding claim 11, Soules in view of Weitzen discloses the value document according to claim 1, wherein the second feature substance is printed on the value document substrate (see Weitzen col. 1, lines 31-35)

Regarding claim 15, Soules in view of Weitzen discloses a method for producing a value document according to claim 1, comprising the steps: i) incorporating the first feature substance into the volume and substance of the value document substrate (see Soules fig. 7); and ii) applying the second feature substance to the value document substrate in the form of a coding (see Weitzen col. 1, lines 37-39).

Regarding claim 16, Soules in view of Weitzen discloses the production method according to claim 15, wherein the second feature substance is printed on the value document substrate (see Weitzen col. 1, lines 31-35).

Regarding claim 21, Soules, as modified by Weitzen (in the manner set forth in the rejection of claim 1, above), discloses a method for checking or processing a value document according to claim 1, comprising the steps: checking the authenticity and value of the value document by checking the authenticity of the value document by using at least one spectral characteristic property of either or both the first feature

Art Unit: 3725

substance and the luminescent substance of the second feature substance (see Soules abstract), and using the coding formed by the luminescent substance of the second feature substance for carrying out value recognition of the value document (see Weitzen col. 11, lines 2-5).

Regarding claim 22, Soules in view of Weitzen discloses the method according to claim 21, wherein at least one spectral characteristic property of the first feature substance is used for checking the authenticity of the value document, and the coding provided formed by the first feature substance is used for the value recognition of the value document, by a user of a first user group.

Regarding claim 23, Soules in view of Weitzen discloses the method according to claim 22, wherein at least one spectral characteristic property of the luminescent substance of the second feature substance is used for checking the authenticity of the value document (note that the absence of a Soules bar code could serve as an indicator of lack of authenticity), and the coding formed by the luminescent substance of the second feature substance is used for the value recognition of the value document (see Weitzen col. 3, lines 58-61), by a user of a second user group.

Regarding claim 30, Soules in view of Weitzen discloses the value document according to claim 6, wherein the coding extends over substantially the total surface of the value document (see Weitzen fig. 1).

5. Claims 3-5, 13-14, 18-20, 24-29 and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soules in view of Weitzen and further in view of U.S. Patent No. 6,506,476 to Kaule et al. ("Kaule").

Art Unit: 3725

Regarding claim 3, Soules in view of Weitzen discloses the value document according to claim 1, but fails to disclose a third feature substance being provided on the value document substrate, which is different from the first and second feature substances.

Kaule teaches the concept of providing a third feature substance (luminescent substance 6) on a value document substrate (see fig. 3), said third feature substance being different from the aforementioned first and second feature substances (note that the Kaule element is indeed different from those taught by Soules and Weitzen).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to dispose the Kaule luminescent substance upon the value document of Soules in view of Weitzen either separately or along with the mixture of the first and second substances, in order to provide another authentication feature, as explicitly taught by Kaule (see col. 1, lines 5-8).

Regarding claim 4, Soules in view of Weitzen and further in view of Kaule discloses the value document according to claim 3, wherein one of the third feature substance is formed by at least one of a luminescent substance and a mixture of luminescent substances (see Kaule col. 1, lines 5-8).

Regarding claim 5, Soules in view of Weitzen and further in view of Kaule discloses the value document according to claim 1, wherein at least one of the feature substances is formed on the basis of a host lattice doped with rare earth elements (see Kaule col. 1, lines 5-8).

Art Unit: 3725

Regarding claim 13, Soules in view of Weitzen and further in view of Kaule discloses the value document according to claim 3, wherein the third feature substance is provided on the value document substrate in the form of a coding (see Kaule col. 3, lines 32-34).

Regarding claim 14, Soules in view of Weitzen, as modified by Kaule (in the manner set forth in the rejection of claim 3, above), discloses the value document according to claim 1, wherein the third feature substance is printed on the value document substrate together with a printing ink in the form of a printed image (see Kaule col. 3, lines 14-18; see also col. 3, lines 32-34).

Regarding claim 18, Soules in view of Weitzen, as modified by Kaule (in the manner set forth in the rejection of claim 3, above), discloses the production method according to claim 15, wherein a third feature substances is applied to the value document substrate (see the combination set forth in the rejection of claim 3, above).

Regarding claim 19, Soules in view of Weitzen and further in view of Kaule discloses the production method according to claim 18, wherein the second and third feature substances are applied to the value document substrate as a mixture (see the combination set forth in the rejection of claim 3, above).

Regarding claim 20, Soules in view of Weitzen and further in view of Kaule discloses the production method according to claim 18, wherein the third feature substance is printed on the value document substrate together with a printing ink in the form of a printed image (see Kaule col. 3, lines 14-18; see also col. 3, lines 32-34).

Art Unit: 3725

Regarding claim 24, Soules in view of Weitzen, as modified by Kaule (in the manner set forth in the rejection of claim 3, above), discloses the method according to claim 23, wherein at least one spectral characteristic property of at least one of the first and third feature substance that is different from the first and second feature substance is used for checking the authenticity of the value document (the particular luminescence of the Kaule substrate), and the coding formed by the first feature substance is used for the value recognition of the value document (see Soules abstract), if the user belongs to the first user group, and at least one spectral characteristic property of the second feature substance (the particular luminescence of the Weitzen substance) is used for checking the authenticity of the value document, and the coding formed by the second feature substance is used for the value recognition of the value document (see Weitzen col. 3, lines 58-61), if the user belongs to the second user group.

Regarding claim 25, Soules in view of Weitzen and further in view of Kaule discloses the method according to claim 24, wherein, for the authenticity check or value recognition by a user of the first user group, the first feature substance is irradiated with radiation from its excitation range, the emission is determined at least one wavelength from the emission range of the first feature substance (note that in order to properly inspect the value document, a user will naturally hold the document at a distance that is greater than one wavelength from the emission range), and the check of at least one of authenticity and the value recognition is carried out on the basis of the determined emission (see the combination set forth in the rejection of claim 1, above).

Regarding claim 26, Soules in view of Weitzen and further in view of Kaule discloses the method according to claim 25, wherein for the authenticity check or value recognition by a user of the second user group the second feature substance is irradiated with radiation from its excitation range, the emission is determined at at least one wavelength from the emission range of the second feature substance (note that in order to properly inspect the value document, a user will naturally hold the document at a distance that is greater than one wavelength from the emission range), and the check of at least one of authenticity and the value recognition is carried out on the basis of the determined emission (see the combination set forth in the rejection of claim 1, above).

Regarding claim 27, Soules in view of Weitzen and further in view of Kaule discloses the method according to claim 26, wherein at least one of the first and second feature substance is irradiated with at least one of visible and infrared radiation (see Soules col. 2, lines 26-30), and the emission of the irradiated feature substance is determined in the infrared spectral range (see Soules col. 2, lines 26-30).

Regarding claim 28, Soules in view of Weitzen and further in view of Kaule discloses the method according to claim 25, wherein the irradiation is performed with a light-emitting diode or laser diode (see Kaule col. 5, lines 35-39, specifying that various light sources, such as halogen lamps may be used to inspect encoded value documents; note that per the Merriam-Webster dictionary, a “diode” is “an electronic device that has two terminals”; note further that a halogen lamp is an electronic device that has two terminals; note further that halogen lamps emit light; accordingly, the halogen lamps taught by Kaule are “light-emitting diodes”).

Art Unit: 3725

Regarding claim 29, Soules in view of Weitzen and further in view of Kaule discloses the value document according to claim 3, wherein the third feature substance is provided as a printing (see Kaule col. 3, lines 14-18; see also col. 3, lines 32-34).

Regarding claim 32, Soules in view of Weitzen and further in view of Kaule discloses the value document according to claim 13, wherein the third feature substance is provided as a printing (see Kaule col. 3, lines 14-18; see also col. 3, lines 32-34).

Regarding claim 33, Soules in view of Weitzen and further in view of Kaule discloses the production method according to claim 18, wherein the third feature substance is applied by printing (see Kaule col. 3, lines 14-18; see also col. 3, lines 32-34).

Regarding claim 34, Soules in view of Weitzen and further in view of Kaule discloses the production method according to claim 19, wherein the second and third feature substances are applied to the value document substrate as separate substances (see the combination set forth in the rejection of claim 3, above).

6. Claims 9, 12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soules in view of Weitzen and further in view of U.S. Patent Application Publication No. 2004/0084277 to Blair ("Blair").

Regarding claim 9, Soules in view of Weitzen discloses the value document according to claim 1, but fails to disclose the value document substrate comprising a printed or unprinted cotton paper.

Art Unit: 3725

Blair teaches the concept of providing a value document substrate comprising a printed or unprinted cotton paper (see paragraph 6, lines 6-7).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to use the Blair cotton pulp in order to make the document of value of Soules in view of Weitzen, in order to give it better durability than commercial papers and a distinctive feel, as explicitly taught by Blair (see paragraph 6, lines 7-9).

Regarding claim 12, Soules in view of Weitzen, as modified by Blair (in the manner set forth in the rejection of claim 9, above), discloses the value document according to claim 1, wherein the substrate is paper formed from a moist paper web during its production (note that the use of the Blair cotton pulp requires that the value document consist of a moist paper web at some point during its production), and the second feature substance is applied to the moist paper web in the form of the coding during papermaking (see the combination set forth in the rejection of claim 9, above).

Regarding claim 17, Soules in view of Weitzen, as modified by Blair (in the manner set forth in the rejection of claim 9, above), discloses the production method according to claim 15, wherein the value document substrate is formed by a printed or unprinted cotton paper formed from a moist paper web during its production (note that the use of the Blair cotton pulp requires that the value document consist of a moist paper web at some point during its production), and the second feature substance is sprayed onto the moist paper web during papermaking (see the combination set forth in the rejection of claim 9, above).

Response to Arguments

In response to Applicants' argument that Examiner has failed to establish a prima facie case of obviousness in rejecting claim 1 (see Applicants' Arguments/Remarks pg. 9, lines 21-24), Examiner respectfully asserts that both Soules and Weitzen concern documents of value. Accordingly, it would have been obvious to a person of ordinary skill in the art at the time of the invention to employ the features of one in the other (i.e. utilize the Weitzen security features in the Soules cards).

In response to Applicants' argument that Examiner has not informed Applicants of the manner in which Soules could be modified in accordance with the teachings of Weitzen to produce the claimed structure of claim 1 (see Applicants' Arguments/Remarks pg. 12, lines 2-4), Examiner respectfully asserts that the Weitzen coding may simply be applied to the Soules card substrate.

In response to Applicants' argument that Soules and Weitzen fail to disclose the method expressed in the claims involving checking or processing a value document made in accordance with claim 1 by checking the authenticity of the value document using one spectral characteristic property of either or both the first luminescent feature substance and the second luminescent feature substance, and checking the value of the document by using the coding formed by the luminescence substance of the second feature substance (see Applicants' Arguments/Remarks pg. 12, lines 12-18), Examiner respectfully asserts that Soules teaches one to use a coding in order to determine the value of a card (and in doing so, verifying the authenticity of said card) and Weitzen teaches one to similarly check a value of a card.

In response to Applicants' argument that Kaule fails to disclose a third feature substance (see Applicants' Arguemnts/Remarks pg. 12, line 28- pg. 13, line 3), Examiner respectfully asserts Soules and Weitzen disclose first and second feature substances, and Kaule presents another feature substance, which may appropriately be deemed a "third" feature substance.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUSTIN V. LEWIS whose telephone number is (571)270-5052. The examiner can normally be reached on M-F 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on (571) 272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3725

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dana Ross/

Supervisory Patent Examiner, Art Unit 3725

/JVL/